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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/662,958
	Filing Date	September 15, 2000
	First Named Inventor	Ganesh Mani
	Art Unit	3621
	Examiner Name	James A. Regan
Total Number of Pages in This Submission	Attorney Docket Number	284355-00003-1

ENCLOSURES (Check all that apply)

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Firm or Individual name	David C. Jenkins Eckert Seamans Cherin & Mellott, LLC
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Date	July 25, 2006

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Examiner: James A. Reagan

Group Art Unit: 3621

In re Application of:
GANESH MANI

Serial No. 09/662,958

Filed: September 15, 2000

METHODS AND SYSTEMS FOR
ELECTRONIC AGENCY IN
PERFORMANCE OF SERVICES

Attorney Docket No. 284355-00003-1

SUPPLEMENTAL REPLY TO EXAMINER'S ANSWER

July 25, 2006

Commissioner for Patents
MAIL STOP APPEAL BRIEF - PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply is filed in response to the Examiner's Answer, dated June 15, 2006, the time for response being before August 15, 2006.

Argument

In the Examiner's Answer, the Examiner has restated the rejections of the claims substantially as set forth in the final Office Action dated September 17, 2004. The Examiner has further provided a response to the Appellant's arguments. With regard to the rejections of the claims, Appellant relies on his prior arguments as set forth in the Appeal Brief. In reply to the Examiner's response to the Appellant's arguments, Appellant provides the following remarks.

Initially, while noting that the cited art discloses a traditional, power of attorney disposed on paper that is then converted into an electronic form, the Examiner contends that the phrase "electronic power of attorney" as used in the claims refers to "the particular method for storing/transferring the document" as opposed to describing the nature of the claimed power of attorney. Answer at 9. Thus, the Examiner concluded that the power of attorney recited in the claims of the

present application reads upon the cited art. The Examiner, however, is wrong for at least two reasons; first the Examiner is improperly equating the phrase “electronic power of attorney” with “a power of attorney converted to an electronic form,” and, second, the Examiner has ignored the fact that the claim recites a step of “*establishing* an electronic power of attorney.” These points will be addressed in turn.

The Examiner has, essentially, cut the phrase “electronic power of attorney” into two separate elements, “electronic” and “power of attorney,” thereby ignoring the fact that the word “electronic” is an adjective which defines the nature of the “power of attorney.” The Examiner’s act of disassociating the word “electronic” from the phrase it modifies is improper. First, even prior to the Internet age, the word “electronic” has been used as an adjective used to describe traditional objects or services that have evolved into substantially new objects or services which, while performing the same function as their traditional counterparts are completely different therefrom. That is, the addition of the word “electronic” as an adjective clearly defines the new object or service as being different from the traditional object or service. For example, a “can opener” and an “electric can opener” serve the same purpose, to open cans; however, these two objects are clearly distinct and are not easily confused. Thus, although the phrase “can opener” may be used to indicate either a traditional or electrical can opener, if one were asked to draw or describe an “electric can opener,” one would not draw or describe a traditional can opener. Therefore, it is the inclusion of the word “electrical” that defines the nature of the can opener and identifies an electric can opener as being different from a traditional can opener.

Similarly, since the Internet has gained widespread popularity, electronic communications have supplemented, or supplanted, traditional paper transactions, such as mail and payment by check. These services are typically described using the adjective “electronic,” or sometimes the abbreviation “e,” to modify the traditional service name. Certainly the most common is “e-mail” (electronic mail), which has distinct features that are not easily confused with traditional paper mail. E-mail, by its nature, is created, and primarily exists, in an electronic format, *i.e.*, cyberspace. Thus, as is commonly understood, and certainly understood by those skilled in the art, if one were asked to write an e-mail, one would access an e-mail program on an electronic device, write a message, and send the message electronically. Conversely, if one

were asked to write an e-mail, one would not write a pen-to-paper message and convert that message into a digital medium and send the message electronically.

The same rationale applies to services performed electronically, such as “electronic checking.” If a business allows customers to pay by “electronic checks,” it is understood that the customer may transfer money electronically from a checking account to the business. One would not think to write a traditional paper check, scan the check to create a digital copy, and forward the digital copy to the business. In fact, until the enactment of the “Check Clearing for the 21st Century Act” in 2003, at least two years after this application was filed, a business could not accept such a digital copy of a check, and may now only do so if specific requirements are met. *See*, 12 U.S.C. §5001 *et seq.*

Thus, the use of the word “electronic” to describe an object or service clearly identifies the object or service as something different from the traditional object or service. When applied to services or communications, the word “electronic” clearly indicates that the service or communication exists in cyberspace and not in a physical form. Thus, given that an “electronic” document is different from a traditional paper document, those skilled in the art would not conclude that an “electronic power of attorney” is a traditional power of attorney that has been converted into an electronic form.

The Examiner, however, asserts that, “even if the power of attorney form is stored on a floppy disk and physically transported to a receiving computer, the power of attorney form is ‘electronic’ simply by virtue of the fact that it is electronically stored on a memory media.” By this rationale, if one were to write a pen-to-paper letter, utilize a scanner to convert the letter into a digital file, save that file on a disk and hand deliver that disk to another, the Examiner would say the first party has sent an “e-mail.” When discussing computer implemented services, this is clearly not how the adjective “electronic” is used by those skilled in the art or even those with a common knowledge of e-mail. Therefore, the Examiner is incorrect to state that a traditional paper power of attorney that is converted into a digital form is the same as an “electronic power of attorney.”

The Examiner has further failed to account for the fact that Claim 1 recites the step of “*establishing* an electronic power of attorney.” In the common vernacular and to those skilled in the art, the phrase “to establish a power of attorney,” has a specific

meaning, namely the creation of a principle/agent relationship. That is, a “power of attorney” is a “legal instrument authorizing one to act as the attorney or agent of the grantor.” (*See*, Merriam-Webster Online Dictionary at <http://www.m-w.com/cgi-bin/dictionary?book=Dictionary&va=power+of+attorney>.) Further, the word “establishing” is defined as “to bring into existence.” (*See*, Merriam-Webster Online Dictionary at <http://www.m-w.com/cgi-bin/dictionary?book=Dictionary&va=establish>.) *See also*, MPEP 1807 *et seq.*, and Patent Office web site FAQ regarding Form SB/80 at <http://www.uspto.gov/go/forms/moreinfosb80.htm>. Thus, as Claim 1 recites the step of “bringing into existence” an “electronic power of attorney,” this step relates to the creation of the principle/agent relationship and the word “electronic” identifies that this action occurs over the communications medium and not on paper.

Conversely, the act of creating a digital version of a paper document is identified as “establishing” an electronic document. Such an action, the creation of a digital version of a paper document, is better described as “digitizing,” “converting” or “scanning” the document.” (*See e.g.*, the definition of “digitizing” in the Merriam-Webster Online Dictionary at <http://www.m-w.com/cgi-bin/dictionary?book=Dictionary&va=digitizing>.) These words speak to creating a copy of a document that already exists in one medium in a different medium. For example, if asked to create an electronic copy of a photograph, one skilled in the art of computers would not say, “I will establish an electronic copy of the photo,” but rather, “I will scan the photo” or “I will digitize the photo.”

Further, given that using a document to “establish a power of attorney” refers to the creation of a principle/agent relationship resulting from the signing of the document, any subsequent conversion of that document to a digital format does nothing to further “create” or “establish” the principle/agent relationship. That is, providing that the other elements of a principle/agent relationship, *e.g.* mutual assent of the parties, etc., exist, the principle/agent relationship is created upon the signing of the power of attorney document. That is, the signing of the document establishes the power of attorney. Once the power of attorney has been established, no further processing of the power of attorney document, such as converting the document into a digital image, is required. Thus, in view of the common understanding of the phrase “establish a power of attorney,” it can be seen that the Examiner’s interpretation of

the phrase “establishing an electronic power of attorney” as meaning the signing of a paper power of attorney and converting a paper document into a digital copy is incorrect. Simply put, the Examiner has applied an overly broad and/or incorrect definition of the word “established” to the claims, a definition that is neither supported by the specification nor by the words used in the claims.

With regard to the rejections under 35 U.S.C. §103(a), the Examiner has also stated that *Lloyd*, U.S. Patent No. 4,876,648, “discloses that notices are **automatically** sent to the borrower and lender and include a power of attorney.” Answer at 9 (citing *Lloyd* at Col. 7, L. 66 to Col. 8, L. 28) (emphasis added). The Examiner has, however, improperly equated “automatic” with “electronic.” That is, as noted in the sentence just prior to the section the Examiner relies upon, *Lloyd* states that, “Thirty days prior to the date, the program sends a **notice** of the option and then choices that are available to the borrower **by registered mail.**” *Lloyd* at Col. 7, L. 60-62 (Emphasis added). That is, *Lloyd* discloses the use of a traditional printed power of attorney disposed on a paper document. Thus, while *Lloyd* may disclose the use of a computer to automatically generate the paper notice that includes a power of attorney form, *Lloyd* does not disclose the use of an “electronic power of attorney.”

The Examiner has further cited *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir 1992) for the proposition that “obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found in either the references themselves or in the knowledge generally available to one of ordinary skill in the art.” Answer at 10. The Examiner further indicated that “it would have been obvious to one having ordinary skill in the business art that the user may execute a power of attorney in order to delegate authority to the exchange so that it may select, on the user’s behalf, the expert that qualifies for the job.” *Id.* at 11. The Examiner, however, has not applied the standard set forth in the cases cited in the Office Action.

In *Fine*, the court initially notes that the Patent and Trademark Office has the burden of establishing a *prima facie* case of obviousness and further states that, “this burden [can be satisfied] only by *showing* some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” 5 USPQ2d at 1598

(emphasis added). The court then noted that the Examiner in that case had failed to show the requisite teaching or suggestion in the cited references and that the Examiner's "bald assertion" without any support or explanation did not satisfy the Patent and Trademark Office's burden. *See*, 5 USPQ2d at 1599. Similarly, the court in *Jones*, which cited *Fine* to establish the rule, noted that because the Patent and Trademark Office failed to present any evidence that one skilled in the art would have been motivated to combine the cited references, the Patent and Trademark Office did not establish a *prima facie* case of obviousness. *See*, 21 USPQ2d at 1944.

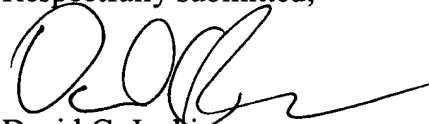
Here, the rejections under 35 U.S.C. §103(a) are improper because the Examiner has not *shown* that there is a suggestion that the cited references should be combined. The Examiner, essentially, makes a bald assertion that the references may be combined. That is, the Examiner has simply cited selected elements from two different references and said they may be combined. Such a combination, however, has not been supported by any evidence. The Examiner's error is rooted in the misinterpretation of the rule set forth in *Fine*. The Examiner contends that "obviousness can only be *established by combining or modifying* the teachings of the prior art." However, *Fine* actually states that the Patent and Trademark Office's burden can be satisfied only by *showing* that knowledge generally available to one of ordinary skill would lead to the combination of the relevant teachings of the references. Accordingly, in this application, as in *Jones*, the Examiner has failed to present any "*evidence*, other than the PTO's speculation (if it can be called evidence) that one skilled in the art would have been motivated [to combine the references]" 21 USPQ2d at 1944 (emphasis in original). As such, in this application, as in *Jones*, "the PTO did not establish a *prima facie* case of obviousness...." *Id.*

As the Examiner has failed to properly support the rejections under 35 U.S.C. §103(a), the Board should reverse the Examiner's rejections of Claims 1-70 and 90-93 and remand the application to the Examiner for the issuance of a Notice of Allowance.

Conclusion

Based on the foregoing, it is respectfully submitted that the Examiner has failed to rebut the argument set forth in Appellant's Brief that Claims 1-70 and 90-93 are patentable over the prior art. Therefore, it is respectfully requested that the Board reverse the Examiner's rejections of Claims 1-70 and 90-93 and remand the application to the Examiner for the issuance of a Notice of Allowance.

Respectfully submitted,



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